

REMARKS

The Examiner's action dated March 30, 2005, has been received, and its contents carefully noted. The indication of allowability of claims 8-10 is noted with appreciation. In view of this indication, claim 7 has been amended to incorporate therein all of the subject matter of allowable claim 8, claim 8 has itself been canceled, and claim 9 has been amended to be in independent form and to include all of the subject matter of the previous version of claim 7. A new dependent claim 15 has been added. This is identical to claim 11, but depends directly from allowable claim 9. In view of the cancellation of claim 8, the total number of claims in the application has not been increased. Claims 1-7 and 9-15 are pending. Claims 1-6 and 12 are presently withdrawn.

It is thus submitted that claims 7, 9-11, 14 and 15 are now in allowable condition.

The rejection of claim 13 is again respectfully traversed. Claim 13 is directed to a device that comprises means for displacing at least one principal tank, means for transferring coating product, and means for supplying an atomizer with coating products. The applied reference, the '465 publication, does not disclose such means.

In the Examiner's Response to Arguments, at the bottom of page 6, the Examiner asserts the following:

"the mere fact that applicant's Specification is directed to a mechanical method does not prevent a manual operation from reading on the claims."

It should be noted that this statement is not, in fact, applicable to claim 13, which defines *apparatus* and not a method.

In support of this assertion, the Examiner has relied upon *In re Prater*, 162 USPQ 541 (CCPA, 1969). Reliance on that decision with respect to the rejection of claim 13 is particularly inappropriate.

The Examiner has referred in particular to pages 550-551 of the cited decision, which contain, firstly, discussions of the rejections of method claims under 35 USC 112, and then a discussion of the rejection of an apparatus claim. On page 550 and most of the left-hand column of page 551, the Court discusses the interpretation of method claims and concludes that since recitations in method claims can encompass operations performed with pencil and paper, the claims are properly rejectable under 35 USC 112, essentially as broader than the disclosure.

However, beginning at the bottom of the left-hand column on page 551, the Court enters into a discussion of the rejection of an *apparatus* claim and states, firstly:
"Apparatus claim 10 presents quite a different question and, in our view, requires a different answer."

Then, beginning at the bottom of the right-hand column on page 551, the Court states the following:

"We do not perceive of any "mental steps" issue in regard to apparatus claim 10. It is quite clear that claim 10, in typical means-plus-function language as expressly permitted by the third paragraph of 35 USC 112, does not encompass the human being as the "means" or any part thereof. Cf. Brown v. Davis, 116 U.S. 234 (1886); Republic Iron & Steel Co. v. Youngstown Sheet & Tube Co., 272 F. 386 (6th Cir. 1921); Permutit Co. v. Village of Poynette, 61 F.Supp. 305, 66 USPQ 294 (W.D. Wisc. 1945) aff'd per curiam 158 F.2d 799, 72 USPQ 463 (7th Cir. 1947); Wilcox v. Danner, 19 CCPA 802, 53 F.2d 711, 12 USPQ 16 (1931); Mabon v. Sherman, 34 CCPA 991, 161 F.2d 255, 73 USPQ 378 (1947). The pencil, paper, and ruler - referred to by the board in regard [***39] to 35 USC 102 - do not anticipate the claimed "means" since the former additionally require human manipulation."

In support of the rejection, the Examiner additionally relies on *In re Venner*. That decision predated *Prater* by some eleven years and was rendered in the days when courts were still asserting that patentability required the existence of an *invention*. The courts have since agreed that patentability is determined on the basis of 35 U.S.C. §§ 101, 102 and 103 and not on the basis of the nebulous concept of whether or not there is an "invention".

The conclusion of unpatentability in *Venner* was based on a primary reference disclosing a device of the same type as that of the claims in issue and secondary references in the same art disclosing devices that the applicant asserted to establish patentability. In the present case, the rejection of claim 13 is not based on such references.

Moreover, the *Venner* holding cited by the Examiner is a quotation from *In re Rundell*, 9 USPQ 221, which held that "The mere statement that a device is to be operated automatically instead of by hand, without a claim specifying any particular automatic mechanism, is not the statement of an invention." Of course, this decision is of no relevance to claim 13 of the present application, which defines specific structural means.

In addition, the Examiner is again referred to all of the decisions cited in the previous response.

It should be quite clear from all that has been presented above that the present rejection of claim 13 is not justified. All of the cited decisions, including the *Prater* decision relied upon by the Examiner to support the rejection of claim 13, make absolutely clear that a "means plus function" recitation in an apparatus claim does not encompass, and is not anticipated by, actions by a human. Since, therefore, the basis for the rejection of claim 13 has been refuted by numerous court decisions and would be reversed summarily by the Board if applicant were forced to undertake the expense of an appeal, it is submitted that this rejection cannot be maintained.

In view of the foregoing, it is requested that the rejections of record be reconsidered and withdrawn, that the

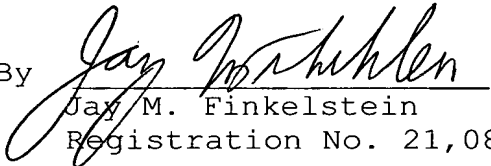
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claims under examination be allowed, that the restriction requirement be withdrawn, and that claims 1-6 and 12 be examined on the merits and allowed.

If the above amendment should not now place the application in condition for allowance, the Examiner is invited to call undersigned counsel to resolve any remaining issues.

Respectfully submitted,

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